

3729



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Philippe, Patrice

Application No.: 09/623,796

Filed: September 8, 2000

For: Method For Making Contactless
Cards

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) Group Art Unit: 3729
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) Examiner: M. Trinh
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) Confirmation No.: 6700
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RESPONSE TO NOTIFICATION OF NON-COMPLIANCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

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TECHNOLOGY CENTER R3700

Appellant respectfully requests reconsideration and withdrawal of the Notification of Non-Compliance with 37 C.F.R. §1.192(c), dated March 16, 2004. The Notification alleges that the Appeal Brief filed January 23, 2004 is defective on five different bases. For the reasons presented below, it is respectfully submitted that the Appeal Brief complies with all of the requirements of the regulation, and therefore should be considered on its merits.

For ease of cross-reference, the following numbered sections correspond to the numbered items in the Notification that were checked as being a basis for non-compliance.

2. 37 C.F.R. §1.192(c)(3)

This portion of the Notice states “The brief does not contain a statement of the status of all claims, pending or canceled, or does not identify the appealed claims...” To the contrary, however, Section III of the brief (captioned “Status of Claims”) states “The present application contains claims 1-8, *all of which are pending and stand finally rejected*” (emphasis added). Hence, the brief clearly identifies the status of all claims.

The next sentence of this section states “The present appeal is directed to dependent claims 4, 5, 6 and 7.” Thus, the brief explicitly identifies the appealed claims.

Nothing more is required to comply with paragraph (c)(3) of the regulation. Notwithstanding that, the brief goes on to explain that, since the appealed claims are dependent claims, all pending claims are reproduced in the Appendix, for the sake of completeness. Furthermore, the next section of the brief (discussed below), explains how it came to be that the appeal is directed to dependent claims. Briefly, after the final Office Action, Appellant attempted to rewrite the appealed claims in independent form, to place them in better condition for appeal. However, for reasons that are not apparent from the record, the Examiner refused to enter such amendment. Consequently, the appealed claims remain in their original, dependent form.

The Notification contains an explanation on page 2 which states that “it is also not known whether the rejected claims 1-3 and 8 are also being appealed...” The basis for this statement is not understood, since Section III of the brief explicitly states that the appeal “is directed to dependent claims 4, 5, 6 and 7.” Furthermore,

the statement of issues in Section VI of the brief explicitly states that “the separate patentability of claim 1 is not being asserted in this appeal.” This statement goes on to explain that the rejection of claim 1 under 35 U.S.C. §112 is being argued because it forms the parent claim from which claims 4-7 depend. In other words, this issue must be resolved to determine the patentability of claims 4-7. The fact that the prior art rejection of claims 1-3 and 8 is not identified in the statement of issues, nor argued in the brief, further reinforces the conclusion that these claims are not being appealed.

III. 37 C.F.R. §1.192(c)(4)

This item in the Notification states that at least one amendment was filed subsequent to the final Office Action, and alleges that “the brief does not contain a statement of the status of each such amendment...” The comment directed to this item states “The brief does not clearly recite that [sic] the exact date of any after final amendment denied entry. For example: ‘no final amendment has been entered ‘.”

These statements are simply unfounded. Section IV of the brief, captioned “Status of Amendments”, states “An amendment was filed subsequent to the final Office Action, on October 27, 2003” (a clear statement of the exact date of the after-final amendment). The first sentence of the second paragraph states “In an Advisory Action dated November 7, 2003, the Examiner refused to enter the Amendment” (an explicit statement that the after-final amendment was not entered).

The brief clearly complies with paragraph (c)(4) of the regulation.

IV. 37 C.F.R. §1.192(c)(5)

This item in the Notification states that the brief “does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters...”

The concise explanation of the claimed invention begins on page 2 of the brief, in Section V, captioned “Summary of the Invention.” This summary comprises seven paragraphs, consisting of an introductory paragraph, a conclusion paragraph, and five intermediate paragraphs explaining technical aspects of the claimed invention. Each of the intermediate paragraphs contains an explicit reference to the portion of the specification, by page and line number, which provides support for the features described in that paragraph. Furthermore, a quick scan of the paragraphs reveals that they each refer to figures of the drawing, and identify specific reference numbers in those figures that relate to the technical features being discussed. The summary therefore clearly complies with paragraph (c)(5) of the regulation.

The comment pertaining to this item states that the summary is “anything but a concise explanation of the invention.” It seems to be suggesting that the summary in the brief is too long, and should only be equivalent to the length of claim 1, i.e. five lines, rather than almost two pages.

It is respectfully submitted that the summary appearing in the brief is consistent with the intent of the regulation. It condenses ten and a half pages of disclosure and four figures into seven paragraphs covering less than two pages. This amount of material is appropriate to assist the Board in quickly coming to an understanding of the subject matter to which the appealed claims are directed. Two pages of explanation does not present such a burden as to be inconsistent with the

purpose of this paragraph of the regulation. To the contrary, if the explanation is reduced any further, material that is essential for an understanding of the invention may be omitted, which would then force the Board to read the entire specification in order to understand the claims. There is no support for the Examiner's suggestion that the concise explanation of the invention should be commensurate in length with the independent claim.

V. 37 C.F.R. §1.192(c)(6)

This item of the Notification states that the brief does not contain a concise statement of the issues presented for review. Contrary to this assertion, Section VI of the brief provides a concise explanation of the four issues that need to be reviewed to determine the patentability of the claims on appeal, namely claims 4-7. One of these issues pertains to compliance with the second paragraph of 35 U.S.C. §112, and the other three issues relate to patentability over prior art references.

The comment pertaining to this item in the Notification seems to be suggesting that, since the after-final amendment was not entered, a petition should be pursued, rather than an appeal. While Appellant does not agree with the refusal to enter the after-final amendment, that decision is not being contested at this time. Rather, Appellant is contesting the *rejections* of claims 4-7, which is an appealable matter. The issues pertaining to the rejections are the same, whether the claims are in independent or dependent form. Accordingly, Appellant is willing to proceed in light of the refusal to enter the after-final amendment, for purposes of this appeal.

VI. 37 C.F.R. §1.192(c)(7)

This item in the Notification states that a single ground of rejection was applied to two or more claims in the application, and that the brief includes the statement that one or more claims do not stand or fall together. However, the Notification goes on to allege that the brief “does not present arguments in support thereof in the argument section of the brief.”


Section VII of the brief contains a statement that claims 4-7 do not stand or fall together, and that each claim presents separate issues of patentability. Thereafter, the patentability of each of these claims is argued in separate respective sections of the brief. Note sections B.1 through B.4 appearing on pages 7-12 of the brief, which point out the different patentable distinctions that each of these claims presents. Appellant has clearly argued the separate grounds for patentability of each of the four appealed claims. The fact that the Examiner does not agree with the Appellant's arguments is not a basis for dismissing the brief as being non-compliant.

For the foregoing reasons, it is respectfully submitted that the Appeal Brief filed on January 23, 2004 clearly complies with each of the requirements of 37 C.F.R. §1.192(c). There is no basis for dismissing the brief on any of the five grounds set forth in the Notification. Withdrawal of the Notification and consideration of the brief on its merits are submitted to be in order.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: April 15, 2004

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